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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

Application Number: 10/064,350
Filing Date: July 03, 2002
Appellant(s): HAWES, TIMOTHY R.

DEC 11 2007

GROUP 3600

John McGarry
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Sept 10, 2007 appealing from the Office action mailed April 7, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-7, 9-11, 13-19, 21, 25 and 30-39.

Claims 12, 20, 22-24, 26-29, and 40-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 has been canceled.

Specifically, Appellant's statement of the Status of Claims as filed with the brief does not include the status of claim 8.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,765,636	BURRELL et al.	10/1973
4,591,178	MORTVEDT et al.	5/1986
5,511,808	ROWLAND	4/1996
6,273,631	TAKAHASHI et al.	8/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 31-39, anticipated by Takahashi et al.

Claims 31-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (US 6,273,631, filed 11/1999). Takahashi et al. teach a mounting bracket for a vehicle wherein the bracket includes an elongated support arm (32) adapted to be mounted to a vehicle element, and defining a longitudinal axis, a length-adjustable link connection (e.g., 4, 6, 7, 8, 10) having a first bracket portion (3) connected to the elongated arm and a second bracket portion (2) adapted to be rotatably connected (through mounting fastener 22) to a vehicle portion (not illustrated), wherein the offset spacing between the arm longitudinal axis and rotational axis may be adjusted by adjusting the length of the link, there being provided a releasable fastener (7, 8) which extends through respective first and second openings (11) in the bracket portions, each bracket having a face (4) with a serration, the serrations meshing when the fastener is not released, the serrations comprising a region of parallel, spaced serrations (either side of opening 11), the second bracket having a further (third) opening (interior of 20) which receives the mounting fastener (22), which may pass through a vehicle element, connected to a vehicle frame, such as an aperture or threaded aperture, the second bracket having a collar (20) which surrounds the third opening, and wherein an end plate (5) is connected to the collar, one side of the end plate forming a corresponding serrated face, the end plate further having a gusset (10) connecting the end plate and collar.

Claims 1-5, 13-19, 21 and 25, obvious over Mortvedt et al. in view of Takahashi et al.

Claims 1-5, 13-19, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortvedt et al. (US 4,591,178, cited by applicant) in view of Takahashi et al. (cited above). Mortvedt et al. teach a fender assembly for a vehicle (10) including a longitudinal frame (12) and ground engaging wheels (16) further including a fender (20) having a linear cross section in a lateral direction (i.e., viewed in cross-section taken along a laterally extending plane), at least one elongated support arm (24-50) mounted to the fender and having a longitudinal axis, and a bracket assembly (38) mounted to the support arm and having a connector (42) for mounting the bracket to the vehicle frame which allows rotation about an axis (e.g., that of 42) spaced from the axis of the support arm, the elongated support arm being mounted to the bracket with a releasable mount (figure 3). The reference to Mortvedt et al. fails to teach a bracket which allows an adjustment of length having first and second portions, connectable together via a fastener, including mating pairs of serrations on opposing sides of the opening through which the fastener extends. Takahashi et al. teach a mounting bracket for a vehicle wherein the bracket includes an elongated support arm (32) adapted to be mounted to a vehicle element and defining a longitudinal axis, a length-adjustable link connection (e.g., 4, 6, 7, 8, 10) having a first bracket portion (3) connected to the elongated arm and a second bracket portion (2) adapted to be rotatably connected (through mounting fastener 22) to a vehicle portion (not illustrated), wherein the offset spacing between the arm longitudinal axis and rotational axis may be adjusted by adjusting the length of the link, there being provided a releasable fastener (7, 8) which extends through respective first and second openings (11) in the bracket portions, the fastener including a nut portion (8) having a threaded interior and a collar portion (abutting the bracket), each bracket having a face (4) with a serration, the serrations meshing when the fastener is not released, the serrations comprising a region of parallel, spaced serrations (either side of opening 11), the second bracket having a further (third) opening (interior of 20) which receives the mounting fastener (22), which may pass through a vehicle element, connected to a vehicle frame, such as an aperture

or threaded aperture, the second bracket having a collar (20) which surrounds the third opening, and wherein an end plate (5) is connected to the collar, one side of the end plate forming a corresponding serrated face, the end plate further having a gusset (10) connecting the end plate and collar. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the bracket portion (38) taught by Mortvedt et al. adjustable using the structure set forth by Takahashi et al., for the purpose of allowing the angle of the fender to be adjusted.

Claims 6, 7, 9, 10 and 11, obvious over Mortvedt et al. in view of Takahashi et al. and Burrell et al.

Claims 6, 7, 9, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortvedt et al. in view of Takahashi et al. and Burrell et al. (US 3,765,636). The references to Mortvedt et al and Takahashi et al. are discussed above and fail to teach the base of the bracket portion carrying the nut as having channel flanges wherein the base of the nut is approximately the same size as the spacing between the channel flanges. Burrell et al. teach an old and well known mechanical fastening arrangement wherein a nut (proximate end of 47, figure 2) is positioned between a pair of flanges (44) spaced so as to be approximately the same size as the nut. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a pair of spaced flanges on the sides of the nut of the fastening arrangement of Mortvedt et al. as modified by Takahashi et al., in view of the arrangement shown by Burrell et al., for the purpose of preventing rotation of the nut when the fastener is being tightened. As regards the particular surface area of the nut (claim 7), it is well known in the fastening arts to adjust the engaging faces of fasteners to provide a desired clamping force on a particular piece of material, and it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the size of the nut to create a desired level of clamping of the two elements. As regards the particular shape of the nut (claim 10), both square and hex nuts, having a footprint comprising 4 and 6 linear edges, respectively, are very well known in the fastening fields and as such it would have been

obvious to one of ordinary skill in the art at the time of the invention to use a square nut in place of a hex nut for the purpose of providing a nut having a greater surface area on its wrench-engaging portions.

Claim 30, obvious over Mortvedt et al. in view of Takahashi et al. and Rowland

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mortvedt et al. in view of Takahashi et al. and Rowland (US 5,511,808). The references to Mortvedt et al., and Takahashi et al. are discussed above and fail to teach the provision of a vibration decoupling coupler connected between the support arm and the fender.

Rowland teaches a vibration decoupling device (20) positioned between a fender mount (26) and a support (38) on a vehicle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a vibration decoupling member such as taught by Rowland between the fender and arm of the vehicle of Mortvedt et al. as modified by Takahashi et al. (e.g., between the fender portion 26 and mounts 52) for the purpose of reducing vibration.

(10) Response to Argument

Applicant's arguments are addressed in substantially the same order as presented in the Appeal Brief.

Claims 31-39, anticipated by Takahashi et al.

Initially, the examiner notes that Appellant's heading in the arguments section refers to Takahashi as being applied to claims 30-39 (heading, section VII, 1.). This appears to be a typographical error, in that the claims rejected by this reference are 31-39, as is consistent with the Office Action, and with Appellant's summary of the Grounds of rejection (section VI, 1.)

Appellant has asserted, with regard to the reference to Takahashi et al. (hereafter "Takahashi") that the reference cannot anticipate the claims as it does not include all the claimed limitations, specifically that Takahashi is not adapted to be

mounted to an upper or lower fender surface. The examiner disagrees with appellant's assertion. While a preamble may give life and meaning to elements recited in a claim, such as appellant's claim 31, the material recited in applicant's preamble ("for a vehicle comprising...") is understood to set out the environment in which the bracket is intended to be used (hence the recitation "for a vehicle having..." rather than a recitation such as "connected to a vehicle having..."). The preamble is not understood to comprise limitations beyond the adaptability of being usable with a vehicle having the elements or arrangement cited in the remainder of the preamble. The reciting of an environment for an intended use is understood to constitute no more than the ability of the recited structure to perform the intended use in the recited environment, which performance the bracket taught by Takahashi can meet. The examiner notes that Appellant has not specified a specific structural feature of the bracket, beyond the adaptability of mounting to a fender, which is not shown in Takahashi, and as such, the examiner understands that appellant may be asserting the reading of further limitations, which are not positively claimed, into the claims. This is not proper in examination of appellant's claims:

From MPEP 2111:

"During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject

matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)."

Appellant's comment that "[t]he Examiner has not stated how a ball shank could be adapted to mount to either the upper or lower surfaces of a fender" is noted, but is somewhat mis-directed as the "ball-shank" element applicant is referring to is simply a rod having a screw-threaded portion, which portions are used to attach the bracket element to vehicle portions, and Appellant is reminded that it is quite well known to mount an item having an aperture to a threaded rod by placing the threaded rod through the aperture and securing it with a nut. The automotive arts are replete with the knowledge of using a threaded fastener to connect one element to another; the Takahashi reference itself suggests that a threaded rod connecting two elements together (e.g., note bolt 7, nut 8 and aperture 11) is certainly well known.

Thus, Takahashi teaches each and every structural limitation which is actually positively recited in the claims. Further, the bracket which is taught by Takahashi is capable of being mounted to a fender (or one of many other elements) to the breadth this intended use is recited and thus is capable of performing the recited intended function or use.

Claims 1-5, 13-19, 21 and 25, obvious over Mortvedt et al. in view of Takahashi et al.

Appellant has initially asserted that there must be a suggestion in the references associated with a combination to make the combination. The recent decision in *KSR International Co. v. Teleflex Inc.* forecloses the argument that a specific teaching, suggestion of motivation is required to support a finding of obviousness. See the recent Board Decision *Ex parte Smith*, --USPQ2d-- slip op. at 20, (Bd., Pat App. & Interf. June 25, 2007)(citing *KSR 82 USPQ2d at 1396*).

Appellant, after describing certain facets of the fender mount taught by Mortvedt et al. (hereafter "Mortvedt"), asserts that the mounting arrangement taught by Mortvedt is believed to be "adaptable for any known tractor", and as such, there is no reason to make the combination of Mortvedt to include an adjustable mounting bracket as taught

by Takahashi. Initially, the examiner notes that the mounting arrangement taught by Mortvedt, despite Appellant's assertions, is quite limited. Firstly, there is no explicit disclosure in Mortvedt that the mounting arrangement that "various models and forms of tractors" (Mortvedt: col. 3, lines 20-21) is equivalent to "any known tractor" (Appellant's assertion). Secondly, Mortvedt's arrangement confines the locus of available positions of the fender to those limited by three fixed dimensions: the fixed radius defined by arm 38, the fixed radius defined by arm 30 and the fixed distance between mounts 52 on the fender. As such, any angular or translational adjustment which does not fall within the bounds allowed by the three fixed dimensions cannot be achieved, as one of ordinary skill would quickly determine. The examiner agrees that Takahashi does not explicitly teach that the length adjustable bracket may be used in place of a non-adjustable bracket on a fender mount, however, one of ordinary skill, realizing the positional limits imposed by Mortvedt's arrangement of fixed-dimension element and noting that Takahashi teaches explicitly the advantageous use of a length-adjustable connector (Takahashi at col. 1, lines 8-13) and which is further advantageously indexable to allow repeatability (Takahashi et col. 2, lines 37-42) in the positioning, would be led to the combination in order to improve the range of motion and angular adjustments which may be had by the otherwise limited mount taught by Mortvedt.

Claims 6, 7, 9, 10 and 11, obvious over Mortvedt et al. in view of Takahashi et al. and Burrell et al.

Appellant has asserted, with respect to the further combination with the reference to Burrell et al. (hereafter "Burrell") that Burrell is not within Appellant's field of endeavor, and as such, is non-analogous art. The examiner acknowledges that the reference to Burrell is directed to a mechanical arrangement which may be used for a different purpose, however both Appellant and Burrell refer to the use of a nut held captive between flanges so as to prevent rotation of the nut: Appellant's own specification, paragraph 0035, describes that the width of the head portion of the nut "is slightly less than the width of the channel 145 formed by gussets 143, to prevent the rotation of the

nut 185 within the channel 145". The provision of the rotationally captive nut in Burrell is for the same reason (see at col. 3, lines 17-20): "...a nut 49 held loosely captive in a cage 50 recessed between gussets 45." As an aside, the examiner notes that the reference numerals 44 and 45 in Burrell's drawings appear to have been applied to two different sets of gussets (compare numerals 44 and 45 in figures 2 and 3) with the indication of gussets 45 in (figure 3) being apparently consistent with the specification passage cited above. The statement of rejection references gussets 44 as shown in figure 2 which correspond to the same gussets referenced by numeral 45 in figure 3.

This aspect of Burrell, which constitutes the specific aspect relied upon for the combination, is then within the same problem-solving arena, at least as regards pertinent use of mechanical fastening expedients. The accommodation of a nut between gussets and is very advantageous through numerous and varied mechanical arts (though the specific elements actually being fastened or mounted may vary), in that it obviates the need for a user to manipulate a tool (e.g., a wrench) to hold the nut from rotating while securing a further element to the nut. As such, the arrangement taught by Burrell is at least reasonably pertinent for the teaching of a mechanical expedient.

As was noted previously, the examiner comments that it is not necessary for the references to teach an explicit motivation to combine, and the previously-cited decision in *KSR* forecloses an argument that the references must explicitly suggest a combination. Appellant has asserted that the examiner has provided no suggestion to support the combination. The examiner does not agree in that a motivation was explicitly set forth in the statement of rejection. It is repeated here: "It would have been obvious ... to provide a pair of spaced flanges on the sides of the nut of the fastening arrangement of Mortvedt et al. as modified by Takahashi et al., in view of the arrangement shown by Burrell et al., for the purpose of preventing rotation of the nut when the fastener is being tightened."

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim 30, obvious over Mortvedt et al. in view of Takahashi et al. and Rowland
Appellant has again asserted that the references must provide a motivation for combining. As has been discussed above, an explicit teaching of a motivation to combine is not required in the references. Appellant asserts that the examiner has not provided a reason for combining the structure of Mortvedt with Takahashi and Rowland. Again, the examiner does not agree, in that a motivation was explicitly set forth in the statement of rejection. It is repeated here: "It would have been obvious ... to provide a vibration decoupling member such as taught by Rowland between the fender and arm of the vehicle of Mortvedt et al. as modified by Takahashi et al. (e.g., between the fender portion 26 and mounts 52) for the purpose of reducing vibration."
Appellant asserts that there is no guidance given as to how the combination is to be made. The statement of rejection is specific in its identification of the envisioned location of the decoupling mount: between Mortvedt's fender portion 26 and the mount portion 52. Such a mounting would place the decoupling element between the support arm and the fender. Further, in view of Rowland teaching the placing of a mount between two elements having generally mating surfaces (e.g., Rowland's elements 26 and 38) one of ordinary skill, noting the location of the decoupling element between generally mating surfaces, would be led to adopt a similar location in Mortvedt, e.g., between mating surfaces of fender portion 26 and bracket portion 52.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Frank Vanaman

A handwritten signature in black ink, appearing to read 'F. Vanaman', followed by the date '12/7/07' written in a similar cursive style.

Conferees:

Meredith Petravick /mcp/

Christopher Ellis /CPE/